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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/573,209 | 08/22/2006 | Martin Prusak | HRG-PT033 (G 5455pct/us) | 7322 |
| 3624 | 7590 | 05/11/2009 | EXAMINER | |
| VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103 | | | HAUTH, GALEN H | |
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| | | | 1791 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/573,209 | Applicant(s) PRUSAK, MARTIN | |
| | Examiner GALEN HAUTH | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-27 is/are pending in the application.
- 4a) Of the above claim(s) 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/24/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 8-20, drawn to a method for setting a strip in a pipe.

Group 2, claim(s) 21-27, drawn to an underground pipe.

2. The inventions listed as Groups 1 and 2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common technical feature of groups 1 and 2 is an underground structure with a strip shaped carrier applied to the internal surface with a heat activated resin that is activated through the use of a heated fluid. The common technical feature was found to not define over the prior art *a posteriori* in view of Andersson et al. (WO 02/01107). Due to the lack of a common **special** technical feature the two groups are subject to restriction.

3. During a telephone conversation with Randolph Huis on 04/30/2009 a provisional election was made without traverse to prosecute the invention of Group 1, claims 8-20.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 21-27 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

4. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise

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require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 8-12 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Andersson et al. (WO 02/01107).

a. With regards to claim 8, Andersson teaches placing an elongated strip of hardenable material on a flattened tube placed inside a pipe with a conduit inside it and heat sealed to the pipe (pg 6 ln 5-30, Fig. 2) by using steam to harden the adhesive (pg 13 ln 10-13) in which the pipe conveys sewage (pg 17 col 3-10).

b. With regards to claim 9, Andersson teaches that the carrier comprises fiber or felt material (pg 9 ln 27-29).

c. With regards to claim 10, Andersson teaches that the conduit carriers computer cables, electric cables, telephone cables, urine, or water (pg 14 ln 18-29).

d. With regards to claim 11, Andersson teaches pressurizing the tube against the surface of the pipe and then hardening the agent (pg 13 ln 1-10).

e. With regards to claim 12, Andersson teaches using steam (pg 13 ln 10-13).

f. With regards to claim 15, Andersson teaches urging the carrier against the inside of the pipe (abstract).

g. With regards to claim 16, Andersson teaches inflating a hose within the tube to urge it against the pipe (pg 8 ln 31-35).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson et al. (WO 02/01107) as applied to claim 8 above, and further in view of Kiest et al. (PN 6206993).

a. With regards to claims 13 and 14, Andersson as applied to claim 8 above teaches conveying a fluid through the carrier, but does not teach causing the fluid to flow in a second direction from a second end to a first end of the carrier.

b. Kiest teaches a method for applying a lining material into a pipe (abstract) in which a device is pushed through the pipe to press the liner against the pipe (col 6 ln 20-30) and heat the material (col 10 ln 52-64). Kiest teaches circulating the hot material through an inlet and outlet hose (col 7 ln 12-22, two way flow by passing down one conduit and into another). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a circulating hot stream with an inlet and outlet conduit in the process of Andersson as taught

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by Kiest, because doing so allows for constant heat to be applied to the liner through circulation of constant temperature steam or water.

10. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson et al. (WO 02/01107) as applied to claim 15 above, and further in view of Goodale (PN 5263515)

a. With regards to claims 17 and 18, Andersson as applied to claim 15 above teaches pressing the carrier against the inside of the pipe, but does not teach urging at least one panel against the carrier.

b. Goodale teaches a method for biasing the inner wall of a tube or pipe using a pair of plates (panels) that expand. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use rounded panels to expand the liner of Andersson as taught by Goodale, given a reasonable expectation of success due to the related function and materials.

11. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson et al. (WO 02/01107) as applied to claim 8 above, and further in view of Sigel (PN 5674030).

a. With regards to claim 19, Andersson as applied to claim 8 above, teaches urging the carrier against the pipe with the use of an expandable hose (pg 13 ln 1-10) but does not teach the use of a robot to advance the carrier through the pipe.

b. Sigel teaches using a pipe repairing machine to advance the liner through a pipe (abstract, col 4 ln 14-26, the repair machine is a robot). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to use a robot to advance the liner, as taught by Sigel, in the process of Andersson, because both relate to the advancement of a liner into a tube to be secured therein.

c. With regards to claim 20, Sigel teaches that the advancing rope is disengaged from the robot once done (col 4 ln 14-26), thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to removably attach the robot to the hose prior to advancement to allow disengagement of the robot from the product.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application as originally filed does not provide a written description nor reasonably convey to one skilled in the art a method of conveying fluid through the liner including **“urging at least one panel against the**

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carrier". The original disclosure provides no explanation of a panel or its urging against the carrier.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GALEN HAUTH whose telephone number is (571)270-5516. The examiner can normally be reached on Monday to Thursday 8:30am-5:00pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571)272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GHH/

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/Christina Johnson/

Supervisory Patent Examiner, Art Unit 1791